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PTO/SB/64 (04-07)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)

13737.00002

First named inventor: **Joseph C. Murray**Application No.: **09/919,747**Art Unit: **3728**Filed: **August 1, 2001**Examiner: **Luan K. Bui**Title: **Insulating Packaging Material and Related Packaging System**

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX: (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions
Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action
by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of
the period set for reply in the office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications
filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee☒ Small entity-fee \$ 770 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))**2. Reply and/or fee****A. The reply and/or fee to the above-noted Office action in**the form of Amendment, IDS (identify type of reply):

- ☐ has been filed previously on _____
- ☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$**12/27/2007 TL0011 00000060 09919747**☐ has been paid previously on **01 FC:2453****770.00 OP**☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending on the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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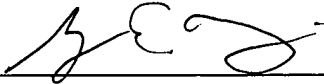
3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE. The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.



Signature

Barry E. Negrin

Typed or printed name

CUSTOMER No. 67883, PRYOR CASHMAN, LLP

Address

410 Park Avenue, New York, NY 10022

Address



Date

37,407

Registration Number, if applicable

212-326-0249

Telephone Number

Enclosures: ☒ Fee Payment☒ Reply☐ Terminal Disclaimer Form☒ Additional sheets containing statements establishing unintentional delay☒ Other: **Return Receipt Postcard**

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

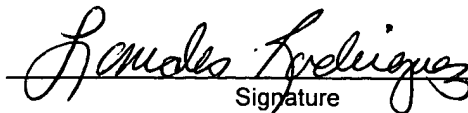
I hereby certify that this correspondence is being:

- ☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

- ☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

Dec. 21, 2007

Date



Signature

Lourdes Rodriguez

Type or printed name of person signing certificate



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/919,747
Inventor: Joseph C. Murray
Filing Date: 08/01/2001
Title: Insulating Packaging Material and
Related Packaging System
Art Unit: 3728
Examiner: Luan K. Bui

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION
UNDER 37 CFR § 1.137(b) AND MPEP § 711.03(c)

I. Introduction

The Owner and Assignee of the above-captioned U.S. Patent Application, (09/919,747, “the ‘747 application”), ThermaFreeze Products Corporation (“ThermaFreeze”), hereby petitions the Office to revive the ‘747 application and consider the enclosed Amendment, which is believed to be fully responsive to the outstanding Office Action. The entire delay in paying the maintenance fee was unintentional. A check in the amount of \$770 is enclosed pursuant to 37 CFR § 1.17(m) (Fee Code 2453). If any additional fees are required to maintain this petition, or if an overpayment has occurred, please charge/credit same to the undersigned’s Deposit Account, No. **50-0932**.

In brief, the inventor herein and president of ThermaFreeze, Joseph Murray, retained a registered patent attorney, C. Emmett Pugh (Reg. No. 22,826), to handle the prosecution and maintenance of the ThermaFreeze patent portfolio. As part of this attorney-client relationship, Mr. Murray had instructed Mr. Pugh to prosecute the ‘747

application. Mr. Pugh failed to do so for this application, and actually allowed it to go abandoned on three separate occasions without informing Mr. Murray of same. There was no way for Mr. Murray to know Mr. Pugh was not maintaining the ThermaFreeze patent portfolio and this patent application in particular.

Mr. Murray was gravely ill with colon cancer from 2001 to the first half of 2006 and focused primarily on his health. During that time, he did manage to inquire of Mr. Pugh concerning the status of the patents and application under Mr. Pugh's care; each time, Mr. Pugh reassured him that everything was "in order." In fact, everything was not in order, despite Mr. Pugh's assurances.

In June 2006, after being diagnosed cancer-free, Mr. Murray had one final substantive conversation with Mr. Pugh concerning the patent portfolio. Initially, Mr. Pugh again reassured Mr. Murray that the patents and application were current. When Mr. Murray began to inquire as to specifics, Mr. Pugh had a massive stroke while speaking to Mr. Murray over the telephone. Mr. Murray's subsequent attempts to reach Mr. Pugh were unsuccessful: either no one answered the telephone, or Mr. Pugh spoke but was totally incoherent. It was not until Mr. Murray and ThermaFreeze retained Pryor Cashman LLP and spoke to patent attorney Barry Negrin (Reg. No. 37,407) on September 28, 2007 that he discovered the truth: that the '747 application had been abandoned on three different occasions (Mr. Murray had also recently learned that Mr. Pugh failed to pay the maintenance fees on three other issued patents). Since that date, Mr. Negrin, along with patent attorney Andrew Langsam (Reg. No. 28,556) and Mr. Murray have been diligently trying to piece together what happened to the '747 application and the ThermaFreeze portfolio in general.

The following will show that, despite Mr. Murray's instructions, Mr. Pugh a) failed to prosecute the '747 application despite having specific instructions to do so; and b) failed to report accurately the status of the '747 application to his client. Mr. Murray had no way to know Mr. Pugh was not doing as instructed, nor did Mr. Murray have any reason to suspect Mr. Pugh was not doing as instructed. Mr. Murray only found out about the status of the '747 application on September 28, 2007, and he and his team have been taking all necessary steps since then to effectuate the revival of the '747 application.

II. Facts that Show Unavoidability of Failure to Pay Maintenance Fees

A. Previous Patent Attorney, C. Emmett Pugh

In 1998, Mr. Murray hired C. Emmett Pugh (Reg. No. 22,826), a registered patent attorney in nearby Louisiana. (Declaration of Joseph C. Murray, hereinafter "Murray Dec.", at ¶ 3.) Mr. Murray had Mr. Pugh prepare and file Mr. Murray's third patent application¹, serial no. 09/079,872, on May 15, 1998, which later matured into U.S. Patent No. 6,269,654 in 2001 ("the '654 patent") on August 7, 2001. (Id.) Mr. Pugh then prepared and filed Mr. Murray's fourth patent application, serial no. 09/366,466, on August 3, 1999, which later matured into U.S. Patent No. 6,536,189 ("the '189 patent") in 2003. (Murray Dec. at ¶ 4.) Mr. Pugh filed a fifth patent application for Mr. Murray, the instant '747 application at issue, a continuation-in-part (CIP) application claiming priority on the fourth application. (Murray Dec. at ¶ 6). Mr. Pugh's office is currently in Suffield, CT. (Declaration of Barry E. Negrin, hereinafter "Negrin Dec.", Exhibit C.)

¹ Mr. Murray's two earlier patent applications, the ones that matured into U.S. Patent Nos. 5,628,845 and 5,966,962, were prepared by a previous attorney.

The first four of the above-referenced patent applications were assigned to Thermal Products, Inc. as they were filed, and the '747 application was supposed to have been assigned to Thermal Products, Inc. (Murray Dec. at ¶ 6). Thermal Products, Inc. was a company founded by Mr. Murray and others in 1994 for the purpose of commercializing the inventions described in the five patent applications. (Murray Dec. at ¶ 7.) Mr. Murray was an officer in Thermal Products, Inc., and Tom Pryor was the CEO and CFO.² (Id.) Thermal Products, Inc. was a small company with very few people. As the main inventor and as an officer, Mr. Murray had primary responsibility for maintaining contact with Mr. Pugh concerning the status of the patent portfolio. (Murray Dec. at ¶ 8.)

B. Mr. Murray Becomes Gravely Ill

In 2000, Mr. Murray began to get sick from a then-unknown illness while abroad. (Murray Dec. at ¶ 9.) The illness got steadily worse during 2001, to the point where travel even within the United States became difficult and then impossible. (Murray Dec. at ¶ 10.) In the spring of 2002, he was diagnosed with stage IV colon cancer and had major surgery on October 31, 2002. (Murray Dec. at ¶ 11.) He underwent numerous rounds of chemotherapy and radiation treatment throughout 2003 and 2004. (Murray Dec. at ¶ 12.) He was chiefly focused on his health, not his business. (Id.)

During this time, Mr. Murray had intermittent contact with Mr. Pugh, which essentially consisted of the instructions to “maintain the patents,” which included the

² Thermal Products, Inc. has recently been restructured/reorganized into ThermaFreeze Products Corporation, of which Mr. Murray is the President.

'747 application (Murray Dec. at ¶ 13.) Mr. Pugh assured Mr. Murray the patents would be maintained and that the '747 application would be worked on when the Office had examined it. (Id.) Mr. Murray was aware of the need to have maintenance fees paid on the issued patents; he instructed Mr. Pugh to pay those fees so that the patents would be maintained. (Id.)

In early 2005, a physical examination uncovered a baseball-size tumor on the back of his liver, which was removed in May of 2005 during a second major surgery. (Murray Dec. at ¶ 15.) During the rest of 2005 and the first portion of 2006, Mr. Murray underwent very extensive chemotherapy and focused predominantly on his health, not his business. (Murray Dec. at ¶ 16.) At some point during that time, Mr. Murray did inquire of Mr. Pugh as to the overall status of the portfolio, the specific payment of the maintenance fees, and the status of the pending '747 application. (Id.) Mr. Pugh reassured him that everything was being taken care of and "in order."

C. The Decline and Death of Tom Pryor

Tom Pryor, the CEO and CFO of Thermal Products, Inc., was also supposed to have some shared responsibility for maintaining contact with Mr. Pugh during the period of 2002-2004. (Murray Dec. at ¶ 14; Negrin Dec Ex. C. at ¶¶ 3-4.) However, in 2001, Mr. Pryor suffered a stroke. He recovered somewhat and continued to serve as CEO and CFO of Thermal Products, Inc. for a while, but in a reduced capacity. Unfortunately, Mr. Pryor passed away in 2004. (Id.) Mr. Pryor used to maintain a home office where he kept many records on behalf of Thermal Products, Inc. (Negrin Dec. Ex. C at ¶ 4.)

Unfortunately, after Mr. Pryor died in 2004, his family relocated residences, and it appears that they discarded all his accounting records for Thermal Products, Inc. (Id.)

D. Mr. Murray's Re-Emergence and Mr. Pugh's Decline

In June 2006, Mr. Murray was diagnosed as cancer-free. (Murray Dec. at ¶ 17.) He immediately began to re-assume the duties and responsibilities of attempting to commercialize the inventions. (Id.) Also in June 2006, he telephoned Mr. Pugh to determine the status of the patent portfolio. (Murray Dec. at ¶ 18.) Mr. Pugh initially said that everything was up to date. (Id.) As Mr. Murray asked for details, however, Mr. Pugh indicated he was experiencing serious physical distress. (Id.) Apparently, Mr. Pugh had suffered a major debilitating stroke while speaking to Mr. Murray on the telephone about the patent portfolio. (Id.)

After that telephone call, over the course of the next several months, Mr. Murray made several additional telephone calls to inquire as to Mr. Pugh's health and to inquire about the details of the patents and pending application. (Murray Dec. at ¶ 19.) On one occasion, Mr. Murray spoke with Mr. Pugh's wife, who indicated he was not well. (Id.) On at least one subsequent occasion, he was able to reach Mr. Pugh directly, however Mr. Pugh was incoherent and did not make any sense. (Id.)

At that point, in 2006 until now, Mr. Pugh appears to have been a sole practitioner, based at least on his website, patentlaw.com. (Negrin Dec. at ¶ 2.) As such, no one else was left in his office who could confirm the status of the ThermaFreeze portfolio and the '747 application in particular as represented by Mr. Pugh.

**E. The Discovery of the Abandonment of the '747 Application
on September 28, 2007**

In late July 2007, Mr. Murray hired new attorneys at the law firm of Pryor Cashman LLP to help with the corporate reorganization of Thermal Products, Inc. into ThermaFreeze Products Corporation. (Murray Dec. at ¶ 22.) Attorney Eric Hellige of Pryor Cashman LLP has been working on the corporate restructuring. (Id.)

In late August 2007, the subject of the patent portfolio came up in discussions between Mr. Murray and Mr. Hellige. (Murray Dec. ¶ 23.) Mr. Hellige subsequently referred Mr. Murray to his law partners, Andrew Langsam (Reg. No. 28,556) and Barry Negrin (Reg. No. 37,407), both patent attorneys. On September 11, 2007, Mr. Langsam was the first person to tell Mr. Murray the actual status of the issued patents: three had expired at the time for failure to pay maintenance fees. (Murray Dec. at ¶ 24.) On September 28, 2007, Mr. Negrin was the first person to tell Mr. Murray the actual status of the '747 application: it had been abandoned three times under Mr. Pugh's watch. (Murray Dec. at ¶ 24; Negrin Dec. at ¶ 5.)

Since September 11, 2007, the patent owners and their counsel have been working closely and assiduously to prepare the instant petition and a similar petition for the unavoidably abandoned '845 and '962 patents. (Murray Dec. at ¶¶ 24-25.) A third U.S. patent, the '189 patent, has been revived for an unintentionally delayed 3 ½ year maintenance fee payment.. (Murray Dec. at ¶ 25.)

As part of the work being done to further the petitions, Mr. Murray and Mr. McGuire attempted to unearth any documentation they might have still had in their respective possessions concerning Mr. Murray's (or any others') instructions to Mr. Pugh regarding maintenance fees. (Negrin Dec. Ex. C at ¶¶ 2-3; Murray Dec. at ¶ 25.) Unfortunately, the records were scarce. (Negrin Dec. Ex. C at ¶¶ 3-4; Murray Dec. at 25.) Mr. Pryor used to maintain a home office where he kept many records on behalf of Thermal Products, Inc. (Negrin Dec. Ex. C at ¶ 4). Unfortunately, after Mr. Pryor died in 2004, his family relocated, and it appears that they discarded all his Thermal Products accounting records. (Id.)

As a last resort, Mr. McGuire actually drove up to Mr. Pugh's office uninvited and unannounced in northern Connecticut from New York City to see if the attorney's files could be located. (Negrin Dec. Ex. C at ¶ 5.) He found Mr. Pugh and his wife at their home which was also Mr. Pugh's work address. (Negrin Dec. Ex. C at ¶ 6.) According to Mrs. Pugh, Mr. Pugh had suffered an embolism two weeks after the June 2006 stroke and was, for a time, completely paralyzed. (Id.) Mr. Pugh had no memory of any of the matters concerned with Mr. Murray or Thermal Products, and he had no idea about any of his files. He was substantially incoherent. (Id.) His wife informed Mr. McGuire that they were imminently moving to New Hampshire so that Mr. Pugh could continue his slow recovery. (Id.) She was unable to say anything about any files. (Id.)

**III. Argument: There Was Nothing That Could Have Reasonably Been Done to
Ensure a Timely Response to the Most Recent Office Action for the '747 Application**

From the above facts, the following basic narrative becomes apparent: Mr. Murray hired Mr. Pugh to prosecute his patent applications and instructed him to pay the maintenance fees for the issued patents, and Mr. Pugh failed to do so, although he advised Mr. Murray that he had. There was no reason for Mr. Murray to doubt Mr. Pugh or assume that Mr. Pugh was not doing the job he was tasked to do; indeed, Mr. Pugh's credentials were impressive (see Negrin Dec. Exhibit A), and he had successfully written three patent applications for Mr. Murray. Mr. Pugh was a registered patent attorney, and Mr. Murray relied on Mr. Pugh for, among other things, prosecuting the '747 application. Mr. Pugh failed to do so.

As it turns out, Mr. Pugh failed to do a lot things in the course of representing Mr. Murray and prosecuting the patent portfolio. He failed to pay the 3 ½ year and 7 ½ year maintenance fees for the '962 patent; he failed to pay the 7 ½ year fee for the '845 patent; and he failed to pay the 3 ½ year fee for the '189 patent. And, of course, he allowed the instant '747 application to go abandoned on *three separate occasions* by not filing timely responses to a Notice to File Missing Parts, a Restriction Requirement, and a first Office Action. (Negrin Dec. at ¶ 5 and Exhibit B thereto.) Something was clearly happening to Mr. Pugh, perhaps a decline in health that manifest itself in forgetfulness or carelessness. Unfortunately, there was no one else in his office to pick up the slack, as he appears to have been a sole practitioner since at least 2004. (See, e.g., Negrin Dec. Ex. A.)

Even if there were some external evidence of something going awry with Mr. Pugh, Mr. Murray was in no position to take significant steps to check up on the patent

attorney whom he trusted. Mr. Murray was, literally, deathly ill for nearly the entire period of time the patent application had been abandoned and the other patents expired until his fateful phone call to Mr. Pugh on June 2006. Mr. Murray is, quite frankly, lucky to be alive, luckier still to be able to work and attempt to commercialize the inventions and the ThermaFreeze patent portfolio. It would not have been reasonable for Mr. Murray --while enduring the trials of surgery, chemotherapy, and radiation therapy-- to be expected to maintain sufficiently close contact with his patent attorney to make sure Mr. Pugh was doing what he was supposed to be doing. Indeed, even a perfectly healthy client would have had no indication something was wrong and thus no motivation to follow up, especially in light of Mr. Pugh's assurances.

Even assuming, *arguendo*, that there was some indication of Mr. Pugh's erratic behavior, there was no one else available to step in. The only other person from Thermal Products, Inc. who might have had any supervisory authority, Tom Pryor, had also had a stroke in 2001 from which he never fully recovered and from which he ultimately passed away in 2004.

IV. Conclusion

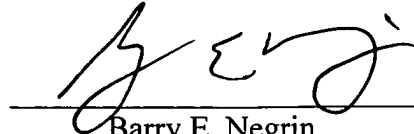
In sum, that the '747 application was abandoned for failure to respond to the more recent Office Action was the result of a concatenation of a number of truly horrible events, none of which could have been prevented. This was truly unintentional (even unavoidable), and it was only discovered recently on September 28, 2007.

**Petition to Revive Unintentionally Abandoned Application
under 37 CFR § 1.137(b) and MPEP § 711.03(c)
U.S. Patent Appl'n No. 09/919,747**

Prompt and favorable action toward the granting of this petition and the revival of
the '747 application is earnestly solicited.

Dated: December 19, 2007

Respectfully submitted,



Barry E. Negrin
Reg. No. 37,407
Attorney for Petitioner

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DEC 21 2007

**CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)**

Applicant(s): JOseph C. Murray

Docket No.

13737.00002

Application No.

09/919,747

Filing Date

August 1, 2001

Examiner

Luan K. Bui

Customer No.

67883

Group Art Unit

3728

Invention: **INSULATING PACKAGING MATERIAL AND RELATED PACKAGING SYSTEM**

I hereby certify that the following correspondence:

**Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(B) ;
Declaration Of Joseph C. Murray; Declaration Of Barry E. Negrin; Amendment And Response To Office Action;
Information Disclosure Statement, 37 CFR §§ 1.97(B); Instructions To Charge The Deposit Account; Return
Receipt Postcard. and a Check for \$770.00**

(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

December 21, 2007*(Date)*Lourdes Rodriguez*(Typed or Printed Name of Person Mailing Correspondence)*
*(Signature of Person Mailing Correspondence)*ED130149710US*("Express Mail" Mailing Label Number)***Note: Each paper must have its own certificate of mailing.**